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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,440	12/14/2001	James J. Bancroft	047329-5001	3710

23345 7590 06/30/2004

MCGUIREWOODS, LLP
1750 TYSONS BLVD
SUITE 1800
MCLEAN, VA 22102

EXAMINER

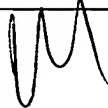
BROWN, MICHAEL A

ART UNIT PAPER NUMBER

3764

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/014,440	BANCROFT, JAMES J. 	
	Examiner	Art Unit	
	Michael Brown	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-31 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Specification***

The disclosure is objected to because of the following informalities: There is no support in the specification for a plurality of divisions in the bite tab dividing the bite tab into three sections, the thickness of the anterior section of the first bite tab portion being different than the thickness of the posterior section of the first bite tab, the anterior and posterior sections of the first bite tab portion having substantially the same thickness, the front and rear surfaces of the frame having a transition separating one surface into first and second portions that are offset from each other, wherein the first portion extends outwardly further than the second portion, the transition including a shoulder and the transition disposed in an outwardly facing front surface .

Appropriate correction is required.

Claim Objections

Claims 10-11, 14-15, 20 and 27-31 are objected to because of the following informalities: These claims are objected to because there is a lack of support in the specification for the structural limitations recited in these claims. In claim 27, the first bite tab portion having a proximal side adjacent the rear surface of the frame member is positively recited more than once. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3764

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-8, 12-13, 16-19, 21-24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bancroft.

Bancroft discloses in figures 1-3 a mouthguard comprising a generally curved, flexible member 11, a central portion (the middle portion of 11 extending from the ends of 18a and 18b towards the center line of 11), a first groove 19c which defines a hinge (col. 2, lines 38-39), a bite tab (fig. 1), projecting inwardly from the central portion, a division 17, a separating the bite tab into first and second bite tabs (18a, 18b), the bite tabs have anterior and posterior sections (fig. 1) of substantially the same thickness (fig. 1), the groove extends generally horizontal (col. 2, lines 48) across the rear surface, the bite tab includes a posterior portion (fig. 1), air holes (13a, 13b) and a helmet strap 20. Bancroft discloses in figures 1-3 a mouthguard comprising a flexible, curved means 11, having a central portion (the portion extending from the ends of 18a, 18b), two ends (fig. 1), a means (18a, 18b) for engaging anterior and posterior teeth and means (19a-19d) for providing flexibility that is a groove.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Croll.

Art Unit: 3764

Croll discloses in figures 1-5 a mouthguard comprising a frame 11, a bite tab 15, a division (27, 33), separating the bite tabs, the division is a narrow opening, the division is a plurality of divisions (33, 33) that divides the bite tab into three sections (the two outer walls that 33 separates from the frame is two divisions and the inner wall that 33 separates from the outer wall is the third division), the bite tab includes a posterior portion (fig. 2), the division is located in posterior and anterior sections of the bite tab (33 is located in the posterior and anterior sections of the bite tab 15, fig. 5), groove 23 in the rear surface of the frame, air holes 13, a helmet strap (can be attached to aperture 21) and the bite tab extends rearwardly past the end portions of the frame (fig. 2).

As for claims 27-31 (as understood) Croll discloses a frame 11 having a transition (the split in 11 at the top of the wall), first bite tab (the left hand side of 15), a second bite tab (the right hand side of 15), the transition includes a shoulder (the vertical edge of the split in 11), the frame includes an upper and lower portion (fig. 2), the transition is disposed in an outwardly facing front surface (fig. 1) and the bite tabs project from a region of the rear surface of the frame adjacent the transition (fig. 2)

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and removal of the objection set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lilly, Durette and Wolicki, each discloses a mouthguard.

Art Unit: 3764

Although each of these references is pertinent prior art, neither was used to reject any claims, in the first office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 703-308-2682. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 703-308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Brown
June 22, 2004



MICHAEL A. BROWN
PRIMARY EXAMINER